REMARKS

Formal Matters

No amendments to the instant claims are presented by way of the current Amendment. Claims 1-7 remain in the instant Application and are presented for the Examiner's review in light of the following comments.

Rejection Under 35 U.S.C. §103

Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Chen, et al., U.S. Patent No. 5,990,377 in view of Applicants' admission further evidenced by Müller, GB Patent No. 2,376,436 A; Roussel, et al., International Publication No. WO 99/45205; Hein, et al., U.S. Patent No. 5,863,107 B2; or Kamps, et al., U.S. Patent No. 5,702,571. Previous arguments made with respect to the references cited by the Examiner remain in effect but will not be repeated for the sake of brevity. Applicants respectfully request the Examiner to consider the following additional arguments with regard to the instant rejection.

1. Applicants' Claim 1 claims a method of making a tissue paper having a transferable lotion disposed thereon. The transferable lotion is transferable to a glass surface upon dynamic contact thereto at a quantity that is at least twice as great as the transfer of the lotion upon stationary contact with a glass surface.

2. It has been found that the instant claimed invention can provide an improved tactile sensation of softness, smoothness, and thickness, as well as a product that avoids unwanted premature lotion transfer while ensuring good lotion transfer to a user when desired. (Specification, p. 2, ll. 18-26) It was also surprisingly found that a lotioned tissue produced by the instant invention, when embossed, delivers a very low amount of lotion when in stationary contact with the surface but delivers a much higher amount of lotion when rubbed over a surface. (Specification, p. 9, ll. 24-27) Such beneficial result may be found when the product is first exposed to the fingertips of a user when taking such a product out of a package and preparing for use. Such transfer to the fingertips of a user is typically undesired and experienced as an unwanted feeling of greasiness – clearly an undesirable result. (Specification, p. 9, l. 30 – p. 10, l. 2)

3. Applicants are at a loss to understand how the *Chen* reference, in combination with the cited secondary references, can even be considered to remotely teach, disclose, or even suggest Applicants' claimed method for making a tissue paper product. While the *Chen* reference discloses that aqueous emulsions and emulsifiable compositions may be used for coating paper

and the like (35:25-43), without a specific disclosure or even a remote suggestion to provide for Applicants' claimed method, these references cannot render Applicants' Claim 1 obvious. "Even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention." *See National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 69 U.S.P.Q. 2d 1614 (Fed. Cir. 2004) (citing *Ecolochem, Inc. v. S. Cal. Edison Co.*, 220 F.3d 1361, 1371 (Fed. Cir. 2000)). "This requirement prevents a Court from labeling as obvious in hindsight a solution that was not obvious to one of ordinary skill at the time of the invention." *See Id.* Thus, a proper obviousness analysis under 35 U.S.C. §103 requires, *inter alia,* consideration of two factors: 1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and 2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *See Noelle v. Lederman,* 355 F.3d 1343, 69 U.S.P.Q. 2d 1508 (Fed. Cir. 2004). Further, "both the suggestion and the reasonable expectation of success 'must be founded in the prior art, not in the applicant's disclosure.'" *See In re Vaeck,* 947 F.2d 488, 493 (Fed. Cir. 1991).

Thus, since Applicants are at a loss to understand how the *Chen* reference and the cited secondary references can be combined in any manner in order to provide for Applicants' claimed method for making a tissue paper product, the references cited by the Examiner cannot sustain a rejection under 35 U.S.C. §103(a). Therefore, in light of the above, Applicants respectfully request the Examiner to withdraw the instant rejection to Applicants' Claim 1 and all claims dependent thereon.

Claims 1-7 have been finally rejected under 35 U.S.C. §103(a) over Luu, et al., U.S. Patent No. 6,352,700 in view of Kamps, et al., U.S. Patent No. 5,702,571. Again, previous arguments made with respect to the *Luu* and *Kamps* references remain in effect but will not be repeated for the sake of brevity. Applicants respectfully request reconsideration and withdrawal of the instant rejection for the following additional reasons

1. The *Luu* reference is primarily concerned with the maintenance of the skin's "acid mantle." (2:64-65) In other words, *Luu* seeks to provide a lotionized tissue, wipe, or non-woven material where the lotion transferred to the skin during use to provide a breathable smooth layer that acts to maintain the skin acid mantle in the proper skin moisture vapor balance. (3:5-12)

2. Again, as discussed with regard to the *Chen* reference *supra,* the *Luu* reference is not concerned with nor even provides any suggestion, motivation, or teaching to provide for a

method of making a tissue paper product where the transferable lotion provides for a transfer that is at least two times greater when in dynamic contact with a glass surface than when in stationary contact with a glass surface. What is clear is that the *Luu* reference is silent on providing a product that avoids unwanted premature lotion transfer while ensuring good lotion transfer to a user when needed, as was found with Applicants' claimed invention. (Specification, p. 2, ll. 25-26) In short, the Examiner has provided no suggestion and reasonable expectation of success in the prior art to suggest Applicants' claimed invention. In short, the *Luu* and *Kamps* references, alone or in combination, fail to disclose, teach, suggest, or render obvious each and every recited feature of Applicants' Claim 1. Applicants therefore request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to Claim 1 and all claims dependent thereon forthwith.

Conclusion

This response represents an earnest effort to place the Application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this Application and allowance of Claims 1-7 is respectfully requested.

If any additional charges are due, the Examiner is authorized to deduct such charge from our Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By _____

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